

## REMARKS

As a preliminary matter, Applicant requests clarification of the status of the April 13, 2009 Office Action with regard to its finality/non-finality. On the PAIR system of the USPTO's website, the April 13, 2009 Office Action is listed as being non-final. Similarly, the last two pages of the body of the Office Action (pages 8 and 9) do not indicate that the Office Action is a final rejection, as customarily included on final rejections. On the other hand, on the Office Action Summary page, Box 2a is checked, indicating that the action is final. Accordingly, clarification of the final/non-final status of the action is requested. In the absence of the receipt of such clarification, Applicant will consider the action as being non-final in accordance with the designation on the PAIR system.

Claim 1 stands rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. Applicant respectfully traverses this rejection.

In the Office Action, the Examiner asserts that the feature defined in lines 8-11 of Claim 1 ("wherein said ring-like element increases the natural frequency of the wheel such that the natural frequency of the wheel is in a frequency band higher than a frequency band of a pneumatic tire mounted thereon") is not present in the Specification., and is therefore considered as new matter.

In response, Applicant respectfully directs the Examiner's attention to paragraphs [0003], [0006], [0007], [0021] and [0022] of the Specification, as originally filed. More specifically, paragraph [0003] of the "Technical Background" section of the Specification discusses the problem of increased resonant action when the natural frequency

of the wheel is close to the natural frequency of the pneumatic tire. Then, paragraphs [0006] and [0007] of the “Disclosure of the Invention” section of the Specification discuss how the addition of a thick element (i.e., such as the claimed “solid ring-like element”) either maintains or increases the natural frequency of a wheel that has been lightened by reducing the thickness of its disk or rim. Finally, paragraphs [0021] and [0022] of the “Best Modes For Carrying Out the Invention” section of the Specification discuss how the ring-like element prevents deformation of the bead seat portion of the wheel, thereby maintaining the natural frequency of the wheel in the natural frequency band that it would have been in prior to lightening of the wheel, which frequency band is “away from the natural frequency of the pneumatic tire,” and thus “[t]he natural frequency of the lightened wheel and the natural frequency of a pneumatic tire attached thereto are, therefore, not close to each other, thus avoiding an increase in a resonant action between the natural frequencies of the wheel and pneumatic tire.”

Accordingly, in light of the portions of the original disclosure discussed above, Applicant respectfully submits that it has been shown that the feature at issue is sufficiently disclosed in the specification as originally filed, and is therefore not new matter. Thus, Applicant respectfully requests the withdrawal of this §112, first paragraph, rejection of independent Claim 1.

Claims 1 and 8-13 stand rejected under 35 U.S.C. §103 as being unpatentable over United States Patent No. 3,799,618 to Martinoli in view of United States Patent No. 5,250,220 to Atwell and further in view of United States Patent No. 5,564,792 to Archibald. Applicant respectfully traverses this rejection.

Applicant respectfully submits that the cited references fail to disclose or suggest all of the features of independent Claims 1 and 12. More specifically, with regard to independent Claim 1, Applicant respectfully submits that the cited references fail to disclose or suggest a wheel that includes, *inter alia*, a solid ring-like element that “increases the natural frequency of the wheel such that the natural frequency of the wheel is in a frequency band higher than a frequency band of a pneumatic tire mounted thereon.” Additionally, Applicant also respectfully submits that the cited references, alone or in combination, fail to disclose or suggest that the claimed single ring-like element is located on the inboard side of the wheel between the hump of the inboard cylindrical bead seat and the inboard annular rim flange, as defined in independent Claim 1. With regard to independent Claim 12, Applicant respectfully submits that the Atwell reference does not disclose or suggest a wheel that includes, *inter alia*, an “inboard annular rim flange [that] includes a radially-extending inboard facing surface that is continuously and completely co-planar with a radially-extending inboard facing surface that extends along the entire radial length of the ring-like element,” as defined in independent Claim 12.

First, with regard to independent Claim 1, Applicant respectfully submits that the Examiner has not shown that the cited references disclose or suggest the frequency feature that the Examiner asserted was new matter. The Examiner did not specifically address this feature in the §103 rejection, but merely asserted that since it was considered as new matter, the combination of the references is considered as meeting this feature. However, since Applicant believes that the new matter issue has been resolved, as indicated

above, the §103 rejection of independent Claim 1 and associated dependent Claims 8-11 and 13 should be withdrawn.

Second, also with regard to independent Claim 1, Applicant respectfully submits that the cited references, alone or in combination, fail to disclose or suggest that the claimed ring-like element is located on the inboard side of the wheel between the hump of the inboard cylindrical bead seat and the inboard annular rim flange. As correctly acknowledged by the Examiner, the proposed combination of Martinoli and Atwell does not show only a single ring-like element located on the rim. *See* April 13, 2009 Office Action, page 4, lines 3-4. Accordingly, the Examiner relied upon the Archibald reference for a teaching related to having only a single ring-like element. *See* April 13, 2009 Office Action, page 4, lines 4-16 and page 7, lines 3-4.

However, even assuming *arguendo* that the Archibald reference could be combined with Martinoli and Atwell, the resulting combination would not be a single ring-like element that is located at the position defined in Claim 1, *i.e.*, on the inboard side of the wheel between the hump of the inboard cylindrical bead seat and the inboard annular rim flange, as defined in independent Claim 1. Instead, one of ordinary skill in the art would have placed such a single ring-like element at the center of mass of the wheel, and not at the inboard side, as taught in numerous places in the Archibald reference (while referring to the “balancing flange 64,” which the Examiner equated with the claimed “ring-like element”). *See e.g.*, Archibald, col. 4 (lines 43-55); col. 5 (lines 11-26), and col. 5 (line 66) through col. 6 (line 3). Accordingly, as it has been shown that the proposed combination of Martinoli, Atwell and Archibald would have lacked the claimed single ring-like element that is located

on the inboard side of the wheel between the hump of the inboard cylindrical bead seat and the inboard annular rim flange, as defined in independent Claim 1, Applicant respectfully requests the withdrawal of this §103 rejection of independent Claim 1 and associated dependent Claims 8-11 and 13 for at least this reason.

Third, with regard to independent Claim 12, Applicant respectfully submits that the cited references do not disclose or suggest a wheel that includes, *inter alia*, an “inboard annular rim flange [that] includes a radially-extending inboard facing surface that is continuously and completely co-planar with a radially-extending inboard facing surface that extends along the entire radial length of the ring-like element,” as defined in independent Claim 12.

Applicant’s Figure 1 shows one example of an embodiment with a radially-extending inboard annular rim flange [22B] including a radially-extending inboard facing surface [22B1] that is continuously and completely co-planar with a radially-extending inboard facing surface [26a] that extends along the entire radial length of the ring-like element [26].

In contrast, as can be seen in Figure 4 of the Atwell reference, assuming *arguendo* that the radially inner portion of circular flange 20 is considered as the claimed “ring-like element,” it can be seen that the radially-extending right-hand surface of this element is not continuously and completely co-planar with the right-hand surface of the portion of the flange that is radially outside of flange 20. In the alternative, assuming *arguendo* that circular flange 18 is considered as the claimed “ring-like element,” it can also be seen that flange 18 also lacks a radially-extending right-hand surface that is continuously

and completely co-planar with a radially-extending right-hand surface of an element that can be considered as equivalent to the claimed annular rim flange. Further, neither the Martinoli reference nor the Archibald reference remedy this deficiency.

In response to Applicant's arguments of Amendment D, the Examiner merely re-asserted the same previous arguments, without really addressing the amendment to Claim 12 of Amendment D (in which Claim 12 was amended from reciting that the radially-extending inboard-facing surface is "*generally* co-planar to a radially-extending inboard facing surface of said ring like-element" (emphasis added) to reciting that it is "continuously and completely co-planar with a radially-extending inboard-facing surface that extends along the entire radial length of said ring-like element " (emphasis added)). Compare April 13, 2009 Office Action, page 7 (line 18) through page 8 (line 3) with September 19, 2008 Office Action, page 4 (lines 11-17). More specifically, the Examiner has failed to address that Claim 12 was amended to recite that a radially-extending inboard-facing surface of the inboard annular rim flange is continuously and completely co-planar with a radially-extending inboard facing surface that extends along the entire radial length of the ring like element. Instead, the Examiner responded to Applicant's previous arguments as if Claim 12 merely recited that the two surfaces were generally co-planar. Accordingly, as the rejection fails to show that the cited references satisfy all of the features of the current language of Claim 12, Applicant respectfully requests the withdrawal of this §103 rejection of independent Claim 12.

Claim 12 stands rejected under 35 U.S.C. §103 as being unpatentable over Atwell in view of Archibald. Applicant respectfully traverses this rejection.

Applicant respectfully requests that the § 103 rejection of independent Claim 12 under Atwell in view of Archibald be withdrawn considering the above-remarks directed to independent Claim 12 when responding to the §103 rejection based on the combination of Martinoli, Atwell and Archibald.

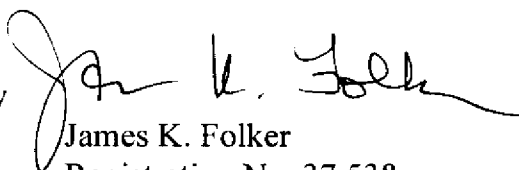
For all of the above reasons, Applicant requests reconsideration and allowance of the claimed invention. The Examiner is invited to contact the undersigned attorney if an interview would expedite prosecution.

If a Petition under 37 C.F.R. §1.136(a) for an extension of time for response is required to make the attached response timely, it is hereby petitioned under 37 C.F.R. §1.136(a) for an extension of time for response in the above-identified application for the period required to make the attached response timely. The Commissioner is hereby authorized to charge fees which may be required to this application under 37 C.F.R. §§1.16-1.17, or credit any overpayment, to Deposit Account No. 07-2069.

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Respectfully submitted,  
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